

REMARKS

In her last action, the Examiner indicated claims 1-3,8,9 and 14 were allowed, and objected to claims 19 and 22-24 for depending from rejected claims.

Claims 17, 18 and 20 were rejected, and claim 17 has been amended to define assuredly over the cited art, and it is respectfully submitted §103 has been applied improperly to reject claim 20. Claim 18 depends from claim 17 and, therefore reconsideration of the rejection of claims 17,18 and 20 is requested.

The Examiner rejected claim 17 under §102 in view of the Valentino patent. Claim 17 has been amended to define the core as part of a “means” clause, and the core is defined as a “weighty mass of dense material provided with sufficient weight for holding a plurality of buoyant party balloons in place... .” Further, the decorative material secured within the decorative bag in a position to conceal the core from casual view is defined as extending outwardly from the bag as the balloon holder is displayed for retail sale, and now forms part of a “means” clause defining such decorative material as providing decorative appeal for the balloon holder at retail display

The inserts of the Valentino patent are certainly not described as weighty mass of dense material, are certainly not “provided,” i.e., designed or engineered, to have sufficient weight to hold a plurality of party balloons, nor are the cardboard inserts of the Valentino patent described as having sufficient weight to hold a plurality of party balloons.

The Examiner held terms such as “dense” or the weight of buoyant balloons are

relative, and suggested air could be considered a dense mass or a cardboard core may be weighty enough to hold one or two balloons. However, as noted in M.P.E.P. 2111.01, "means" clauses in a claim should be interpreted as ascribed in the specification, and assuredly the specification precludes a weighty mass of dense material provided with sufficient weight for holding a plurality of buoyant party balloons in place would not include a cardboard insert.

Further, the Valentino patent does not describe any insert secured within the decorative bag in a position to conceal the core from casual view and that extends outwardly from the bag as the balloon holder is displayed for retail sale to provide decorative appeal for the balloon holder at retail display. The decorative material of the Valentino patent extends outwardly from the bag *after* a retail sale has been made to conceal the purchase within the bag. Reconsideration of the rejection under §102 is thus requested.

Claim 20 had been rejected by the Examiner under §103 in view of the Valentino patent and the Metz patent. The Examiner held it would have been obvious to change the shape of the cardboard core of Valentino "in order to be able to hold more balloons..."

Valentino, or course, does not teach holding any party balloons, and one would have no motivation to substitute a trapezoidal weight as a balloon holder for the cardboard insert holding the fan-folded lengths 18 of paper of Valentino.

The Examiner has not suggested any motivation or suggestion *from the references* to substitute a trapezoidal weight as a balloon holder for the cardboard insert of Valentino.

The Examiner is reconstructing features of the claims from isolated elements of the prior art with the only teaching to do so being applicant's disclosure. Such hindsight reconstruction of the claimed invention is improper. The rejection of claim 1 and the claims depending therefrom is improper under the guidelines of M.P.E.P §2143.01.

With regard to rejecting a claim by substituting an element from one reference to another, "it is necessary to ascertain whether or not the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the reference before him to make the proposed substitution, combination, or other modification." *In re Linter*, 458 F.2d 1013, 1016, 173 U.S.P.Q. 560, 562 (C.C.P.A. 1972).

The Examiner must apply teachings from *the references* to substitute a trapezoidal weight as a balloon holder for the cardboard insert of the Valentino patent. Combining elements of the art to produce the claimed invention is proper only where there is some teaching, suggestion, or motivation to do so found either in the references themselves, or in the knowledge generally available in the art. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988).

The Examiner has relied on impermissible hindsight in making the rejection based upon obviousness. "It is impermissible to engage in hindsight reconstruction of the claimed invention, using the applicant's structure as a template and selecting elements from references to fill the gaps". *In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992). The Examiner has combined isolated features from the references to reconstruct

what he interprets as applicant's claimed invention with the motivation for the combination being applicant's own disclosure or claim language. Such actions by the Examiner violate the strictures of *In re Fritch* in reconstructing the claimed invention by selecting bits and pieces from the prior art by using applicant's disclosure as a guide.

The law is clear that the mere fact that the references can be combined to meet the invention claimed does not render the resultant combination obvious under the Statute unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir 1990). The fact the aspects of the invention may be individually known in the art does not make their combination obvious under the Statute without some reason from the art for the combination of elements proposed by the Examiner. *Ex parte Levingood*, 28 U.S.P.Q.2d 1300 (PTO Bd. Pat. App. & Inter. 1993). It is also improper to rely upon the level of skill in the art to provide the suggestion to combine features of different references. *Al-Site Corp. v. VSI Intl. Inc.*, 174 F.3d 1308, 50 U.S.P.Q.2d 1161 (Fed. Cir. 1999).

Applicant has provided a device which solves the problem of providing a commercially viable decorative balloon holder that may simulate a gift bag and yet can be manufactured, stored, shipped and displayed at retail in a manner preserving the decorative appeal of the balloon holder. Although the solution of applicant's invention may appear simple in hindsight, such simplicity is no basis for rejection. *In re Horn, Horn, Horn and Horn*, 203 U.S.P.Q. 969 (CCPA 1979) and cases cited at page 971.